

REMARKS

Claims 42 to 48 are added, and therefore claims 22 to 48 are now pending in the present application (since claims 1 to 21 were previously canceled).

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,269,482 to Shultz et al., (“Shultz”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 22 is to a prioritization method for prioritizing sensor plug-ins, which are for *coordinating powertrain control of a motor vehicle*. The method includes sorting a list having the plug-ins according to a degree of a rising priority or a falling priority, so as to provide a sorted list; *processing the sorted list sequentially*, beginning with the one of the

plug-ins having a highest priority; *ending the processing of the list as soon as one of the plug-in sensors includes a request command*; and selecting the request command.

It is respectfully submitted that the Shultz reference does not disclose nor even suggest at least the above highlighted features. In particular, any review of the Shultz reference makes plain that it simply does not disclose nor suggest the feature of *coordinating powertrain control* of a motor vehicle, as provided for in the context of the presently claimed subject matter. Indeed, the Final Office Action concedes that “Shultz is silent concerning ... coordinating powertrain control of a motor vehicle” (*Final Office Action*, page 3), but it nevertheless conclusorily asserts that it would have somehow been obvious to use “Shultz priority of sensor plug-ins for display for coordinating powertrain control.” (*Id.*).

Even if the Shultz system did integrate information from disparate technologies and sources, as asserted by the Final Office Action, it is respectfully submitted that this simply does not represent coordinating powertrain control of a motor vehicle, as with the claimed subject matter. That is because Shultz concerns an *information system* -- which is wholly different from the vehicle control provided by the presently claimed subject matter. In this regard Shultz makes clear that it is “directed to an in-vehicle *information system* ... that can *present information* from multiple sources to a vehicle operator.” (*Shultz*, column 1, lines 10 to 12, emphasis added).

The Shultz also states that it “can manage this information in a coherent manner that will not adversely affect driver performance,” so that Shultz provides absolutely no discussion of vehicle control. Accordingly, any speculation that one skilled in the relevant art would be motivated to introduce *coordination of powertrain control* is wholly unsupported, since Shultz concerns an information system and since any coordinating of the powertrain control is simply beyond the scope of the Shultz reference. Thus, one skilled in the art would not be motivated to add the feature of coordination powertrain control to the Shultz reference as asserted by the Final Office Action.

The Shultz reference also does not disclose nor suggest the claim 22 feature of *processing the sorted list sequentially, beginning with the one of the plug-ins having a highest priority*. As to column 11, lines 8 to 50, of Shultz (cited by the Final Office Action), there is no disclosure of processing a list sequentially. For this additional reason claim 22 is allowable.

Still further, the Shultz reference does not disclose nor suggest the claim 22 feature of *ending the processing of the list as soon as one of the plug-in sensors includes a request command*. As to cited column 11, lines 8 to 50, of Shultz (warning of “abnormal or potentially dangerous conditions that occur in the vehicle” (*Final Office Action*, page 2)), this does not disclose nor suggest the feature of *ending the processing of the list* let alone *as soon as one of the plug-in sensors includes a request command*, as provided for in the context of the claimed subject matter. For this additional reason claim 22 is allowable.

In view of the foregoing, claim 22 is allowable, as are its dependent claims.

Claim 26 includes features like 22, and it is therefore allowable for essentially the same reasons as claim 22, as are its dependent claims.

As further regards the obviousness rejection, it is respectfully submitted that the cases of In re Fine, *supra*, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify the reference does not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to

one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

It is believed and respectfully submitted that the present Final Office Action offers no evidence, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying the Shultz reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the Shultz reference makes plain that it simply does not describe the features discussed above of the rejected claims.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 22 to 41 are allowable.

Claims 42 to 48 do not add any new matter and are supported by the present application, including the specification. Claims 42 to 45 depend from claim 22, and they are therefore allowable for the same reasons, and for the further reasons that they include combinations of features that are not disclosed or suggested by the applied references, as any review of the applied references should make plain. Claims 46 to 48 depend from claim 26 (and it claim 27), and they are therefore allowable for the same reasons, and for the further reasons that they include combinations of features that are not disclosed or suggested by the applied references, as any review of the applied references should make plain.

Accordingly, claims 22 to 48 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that claims 22 to 48 are in condition for allowance. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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Dated: _____

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